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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,475	09/22/2003	Roland E. Dolle	VPISW006 DIV	2933

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EXAMINER

MCKENZIE, THOMAS C

ART UNIT PAPER NUMBER

1624

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/668,475

**Applicant(s)**

DOLLE ET AL.

**Examiner**

Thomas McKenzie, Ph.D.

**Art Unit**

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,9 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,9 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This action is in response to an application filed on 9/22/03. There are six claims pending and six under consideration. Claims 1-4 are compound claims. Claim 9 is a composition claim. Claim 14 is a method of using claim. This is the first action on the merits. The application concerns some Pyridazinecarboxamide and Ester compounds, compositions, and uses thereof.

#### *Title*

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: replacing the word "Pyridazines" with "4-Pyridazinecarboxamides and Esters".

#### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

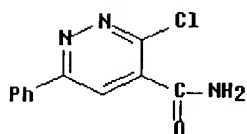
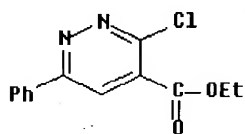
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

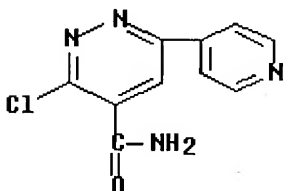
Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Wermuth (J. Med. Chem.). There are two compounds which fit formula (I) with  $R_1$  = chlorine,  $R^2$  = ethoxy and  $NH_2$ , respectively,  $R_3 = R_6$  = hydrogen,  $R_4 =$

phenyl, and  $R_5$  = ethyl and hydrogen respectively. The compounds are found in Table I on page 530 and are compounds 16 and 18. There are also pictured as intermediates in Scheme IV on page 531. The synthesis of the amide compound is taught in the last complete paragraph on page 535.

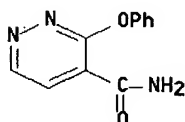


4. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Linz ('233). There is one compound which fits formula (I) with  $R_1$  = chlorine,  $R^2$  = OH,  $R_3 = R_5$  = hydrogen, and  $R_4$  = 4-cyanophenyl. The compound is found in the reference in lines 41-53, column 22 and is Example XIV.

5. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Leshner ('194). There is one compound which fits formula (I) with  $R_1$  = chlorine,  $R^2$  = NH<sub>2</sub>,  $R_3 = R_5 = R_6$  = hydrogen, and  $R_4$  = 4-pyridyl. The compound is found in lines 42-60, column 4 and is compound A-1.



6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Heinisch (Archiv der Pharmazie). There is one compound in this reference which fits formula (I) with  $R_1$  = phenoxy,  $R^2$  =  $\text{NH}_2$ , and  $R_3 = R_4 = R_5 = R_6$  = hydrogen. The compound is found in Schema 2, page 1223 and is compound **9a**. See also compound **9b**. Syntheses of these two species are found in the final two paragraphs on page 1225.



### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214

USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 and 9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,624,166. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims concern eight different  $R_1$  groups including halogen. The formula in claim 1 of U.S. Patent No. 6,624,166 is restricted to  $R_1 = \text{halogen alone}$ . This is a species/genus situation. According to the MPEP §806.04(i) "Generic Claims Presented for First Time After Issue of Species. The Office no longer follows the practice of prohibiting the allowance of generic claims that are presented for the first time after the issuance of a copending application claiming plural species. Instead, the Office may reject the generic claims on the grounds of obviousness-type double patenting. Applicant

may overcome such a rejection by filing a terminal disclaimer. See *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29.”

8. Claim 14 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,121,266. Although the conflicting claims are not identical, they are not patentably distinct from each other because again formula in claim 1 of U.S. Patent No. 6,121,266 is restricted to  $R_1 = \text{halogen alone}$ . The rationalization is presented above..

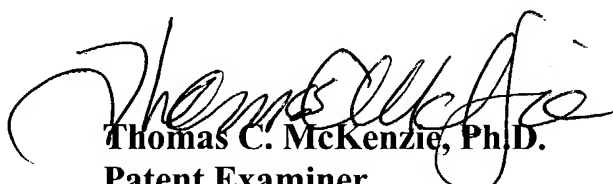
#### ***Conclusion***

9. Information regarding the status of an application should be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free). Please direct general inquiries to the receptionist whose telephone number is (703) 308-1235.

10. Please direct any inquiry concerning this communication or earlier communications from the Examiner to Thomas C McKenzie, Ph. D. whose

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telephone number is (571) 272-0670. The FAX number for amendments is (703) 872-9306. The PTO presently encourages all applicants to communicate by FAX. The Examiner is available from 8:30 to 5:30, Monday through Friday. If attempts to reach the Examiner by telephone are unsuccessful, please contact James O. Wilson, Acting-SPE of 1624 at (571)-272-0661.

  
**Thomas C. McKenzie, Ph.D.**  
**Patent Examiner**  
**Art Unit 1624**

TCMcK